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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/643,288

08/20/2003

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20185 7590 03/02/2009  
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EXAMINER

ROWAN, KURT C

ART UNIT

PAPER NUMBER

3643

MAIL DATE

DELIVERY MODE

03/02/2009

PAPER

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* FRANCIS LUCA CONTE

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Appeal 2008-3533  
Application 10/643,288  
Technology Center 3600

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Decided: March 2, 2009 <sup>1</sup>

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Before: WILLIAM F. PATE, III, JENNIFER D. BAHR and  
JOHN C. KERINS, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## PROCEDURAL HISTORY

The subject application discloses and claims improvements made to the insect swatter disclosed and claimed in application serial number 08/331,851, which was filed on October 31, 1994, and issued as US Patent 6,851,218 on February 8, 2005.

In that case, two appeals were decided by the Board of Patent Appeals and Interferences in Appeal Number 96-3971 and Appeal Number 2000-2033. Appeal number 96-3971 resulted in a full reversal of the Examiner's rejections. Subsequent to that appeal the Examiner reopened prosecution and rejected all claims. That rejection was the subject of Appeal Number 2000-2033 which resulted in a partial affirmance of the rejections. In appeal number 02-1150 to the United States Court of Appeals for the Federal Circuit, a Judgment affirming the Board of Patent Appeals and Interferences decision in Appeal Number 2000-2033, was entered on June 5, 2002.

In the present application, a first appeal was decided by the Board of Patent Appeals and Interferences in Appeal Number 2006-0635, which resulted in a full reversal of the previous rejections, in a decision dated March 9, 2006.

## STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1, 3, 5, 6, and 8-23. We have jurisdiction under 35 U.S.C. § 6(b).

The claims are directed to an insect swatter and method for using it. Claim 1 is illustrative of the claimed apparatus and is reproduced below:

1. An insect swatter comprising:

an elongate rod having a proximal end for being hand-held, and an opposite distal end for being aimed at an insect; and

an elastic lash including only a pair of identical annular rubber bands joined together at a knot therebetween, and having a proximal end fixedly joined and retained to said rod distal end, and an opposite and loose distal end sized for being elastically stretched from said rod distal end to adjacent said rod proximal end so that release of said lash distal end spontaneously contracts said lash for whipping said lash distal end in extended striking range against said insect while said lash is retained at said rod distal end without disconnection therefrom.

Claim 6, which depends from claims 1, 3 and 5, is illustrative of the claimed method and is reproduced below:

6. A method of using the swatter of claim 5 comprising:

stretching said lash by pulling said distal end thereof generally parallel to said rod and adjacent to said rod proximal end, and placing said knot mediate said rod;

latching said lash distal end to said latch;

gripping said handgrip to aim said rod distal end at said insect; and

pulling said trigger to release said latch to spontaneously contract said lash for swatting said insect.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Robinson

102,594

May 3, 1870

White	1,779,507	Oct. 28, 1930
Watkins	2,642,057	June 16, 1953

The following references, previously made of record, are relied upon to support new grounds of rejection issued herein:

Kopp	1,009,531	Nov. 21, 1911
Stone	2,505,591	April 25, 1950

The Examiner rejected claims 1, 3, 5, 6, 8, 10-14, and 17-23 under 35 U.S.C. § 103(a) as being obvious over White in view of Watkins.<sup>2</sup> The Examiner rejected claim 9 under 35 U.S.C. § 103(a) as being obvious over White in view of Watkins and further in view of Robinson. The Examiner rejected claims 1, 3, 5, 6, 8, and 10-23 under 35 U.S.C. § 103(a) as being obvious over Watkins in view of White.<sup>3</sup> Claims 2, 4, and 7 have been cancelled.

#### ISSUE

Has Appellant established that the Examiner has erred in making the following rejections?

1. Claims 1, 3, 5, 6, 8, 10-23 as being obvious over the combination of White and Watkins.

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<sup>2</sup> The Examiner's statement of rejection for White in view of Watkins does not include claims 15 and 16, however, these claims are addressed by the Examiner in the discussion of the rejection. Final Rejection mailed 2/7/07 p. 3.

<sup>3</sup> Unlike the examiner, we do not consider the order in which prior art is applied in a rejection to be significant. *See e.g., In re Bush* 296 F.2d 491, 496.

2. Claim 9 as being obvious over White and Watkins and further in view of Robinson.

#### FINDINGS OF FACT

1. White discloses an elongate rod 1 having a proximal end (at 2) capable of being hand-held, and an opposite distal end (at 3) capable of being aimed at an insect; and an elastic lash (“rubber bands”; p. 1, l. 88) including only a pair of annular rubber bands (“two”; p. 1, l. 87) joined together at a knot 19 therebetween, and having a proximal end (at 3), and an opposite and loose distal end (at 2) sized for being elastically stretched from said rod distal end (at 3) to adjacent said rod proximal end (at 2) so that release of said lash distal (at 2) end spontaneously contracts said lash (p. 2, l. 3).
2. White fails to disclose that the lash is fixedly joined and retained to said rod distal end and the capability of whipping or swatting said lash distal end in extended striking range against said insect while said lash is retained at said rod distal end without disconnection therefrom.
3. White discloses the rubber bands are formed from old inner tire tubes (p. 1, ll. 21-22). While White does not state that the rubber bands are identical, the bands are illustrated as identical in length or circumference, in thickness, in cross section, and, presumably, in material composition (they are stippled the same). The rubber bands of White thus appear identical, and there is little reason to suspect they are not. Thus to a preponderance of the evidence, White discloses that identical rubber bands are used when multiple rubber bands are employed (See also Fig. 1-2).

4. Watkins teaches that it is known in the art of rubber band guns to fixedly join a lash (“rubber band”) 14 proximal end (at 34) to a rod 10 distal end (at 34) so that the lash distal end (at 16) can be whipped (about 34) with said lash 14 being retained at the rod distal end at a keyhole slot (“slot” 34; “keyhole” shape visible in Figs. 2 and 3) without disconnection therefrom (E.g., orientation shown in Figs. 1, 4 and 7). This results in the lash 14 being elastically stretched and inclined upwardly substantially straight (Fig. 2) from the keyhole slot 34 to the latch 18 when latched.
5. White additionally discloses a latch 7 (p. 1 l. 59) pivotally joined (at 8; p. 1, l. 58) adjacent to said rod proximal end (at 2) for releasably latching said lash distal end (via 10); and means (“trigger”) 13 for selectively releasing said latch 7 to release said lash distal end (at 2) to contract the lash.
6. White additionally discloses a gun handgrip (“stock”) 2 fixedly joined to said rod 1 proximal end (at 2); said latch 7 being pivotally joined (at 8) to said handgrip 2; and wherein said latch releasing means 13, 14, 15 includes a trigger 13 operatively joined to said latch (at 14) for releasing said latch 7 upon pulling said trigger 13 (p. 1, l. 94 – p. 1 l. 4).
7. White fails to disclose a latch stop for limiting rotation thereof when said stretched lash pulls said latch into spontaneous abutment with said stop as said lash distal end is released from said latch.
8. White additionally discloses a method of using the rubber band gun comprising cocking (rotating counterclockwise as viewed in Fig. 1) thumbgrip 9 to position latch 7 in a cocked position (Fig. 1); stretching said lash (p. 1, l. 92) by pulling said distal end thereof generally parallel to said rod 1 and adjacent to said rod proximal end (at 7; p. 1, l. 90-96);

placing said knot 19 mediate (along the rod) said rod 1; latching said lash distal end to said latch (p.1, l. 94); gripping said handgrip 2 (intended purpose of the stock is gripping) and pulling said trigger (p. 1, l. 99) to release said latch (p. 2. l. 2) to spontaneously contract said lash (p. 2, l. 4).

9. White fails to disclose gripping said handgrip to aim said rod distal end at said insect and the lash spontaneously contracting for swatting said insect.
10. White additionally discloses an elongate rod 1 having a slot 3 at a distal end thereof; an elastic lash (“rubber band”) configured in a figure eight with first and second knot-less loops at opposite ends (embodiment utilizing only two bands viewed from perspective of Figure 2), and joined together at a knot 19 therebetween. White fails to disclose said lash first loop is fixedly retained in said slot to prevent disconnection therefrom when said lash is whipped along said rod.
11. Watkins teaches that it is known in the art of rubber band guns to fixedly retain a lash 14 in a slot 34 to prevent disconnection therefrom when the lash 14 is whipped along the rod 10.
12. Watkins additionally teaches that it is known in the art that rubber band guns may be converted between operational modes wherein, upon firing, the rubber band itself is ultimately retained on the gun or discharged from it. Col. 4, ll. 66-72.
13. White additionally discloses that the lash includes a pair of rubber bands p. 1, ll. 87-88 joined in series (Figs. 1 and 2) having a collective spring rate equal to one-half the spring rate of either band (an inherent property dictated by Hooke's Law).



14. White additionally discloses the latch 7 extends upwardly (at 10) from said handgrip 2. Watkins teaches the lash substantially straight from said keyhole slot to said latch when latched thereto and said knot is positioned atop said rod (Fig. 1). White and Watkins fail to disclose the keyhole slot opens downwardly.
15. Robinson teaches that it is known in the art of rubber band guns that a means, a, for securing an end of a lash (“elastic cord”), C, may open downwardly in a direction opposite to an upward extension of a latch (“catch”), b, to loosely join the lash to the rod (“barrel”), B.
16. White additionally discloses said latch 7 is pivotable between a cocked position wherein said latch extends generally perpendicularly to said rod for retaining said lash second loop thereon (Fig. 1), and a fired position wherein said latch is inclined forwardly toward said rod distal end for allowing said lash second loop to slip off said latch for spontaneously contracting said lash (spring 16 causing pivot about 8; p. 2, ll. 1-2); and said trigger is operatively joined to said latch (at 20, 14) for releasing said latch 7 to pivot (via 8) from said cocked position (Fig. 1) thereof to said fired position (rotated clockwise when viewed from Fig. 1) thereof upon pulling said trigger 13.
17. White additionally discloses the latch 7 includes a thumbgrip 9 extending generally perpendicularly therefrom (note the lower curved portion shown in Fig. 1 extending about perpendicular from the latch) for manually returning said latch to said cocked position thereof (p. 2, ll. 6-10).
18. White additionally discloses a spring 15 joined between said trigger 13 and said handgrip 2; said trigger 13 being pivotable between a cocked position holding said latch in said cocked position thereof (Fig. 1), and a

fired position (rotated clockwise as viewed in Fig. 1) releasing said latch 7 for pivoting said latch to said fired position thereof; and said spring 15 being positioned for providing a returning force on said trigger 13 to return said trigger to said cocked position thereof upon release of said trigger (p.2, ll. 9-11).

19. White additionally discloses the lash has an unstretched length (i.e., prior to stretching step; p.2 ll. 91-92) and the rod and latch have a collective cocked length measured between the proximal end of the sash and the cocked latch. White fails to disclose that the cocked length is selected for stretching said lash to about its maximum stretchable length without breaking. White discusses using bands of “suitable” length (P. 2, l. 18) and strength (P. 1, l. 88) but does not discuss how to determine what length is suitable.
20. Watkins teaches that it is known in the art of rubber band guns that a variation in length of the rubber band will cause a variation in the impetus imparted to the projectile. Col. 3, ll. 34-37; col. 4, ll. 50-52.
21. The Specification states that the invention may be practiced using “standard rubber bands commercially available at common stationery supply stores.” Spec. ¶ [0055].
22. The prime object of White is to provide a simple toy gun constructed such that when the trigger is released a rubber band is discharged in a straight line toward the object aimed at. P. 1, ll. 4-11.
23. Kopp discloses an insect swatter comprising an elongate rod 2 having a proximal end for being hand-held 1, and an opposite distal end (at 4) for being aimed at an insect (Fig. 1); and an elastic lash 5 having a proximal end fixedly joined and retained to said rod distal end (at 4), and an

opposite and loose distal end (at 6) sized for being elastically stretched from said rod distal end to adjacent said rod proximal end so that release of said lash distal end spontaneously contracts said lash for whipping said lash distal end in extended striking range against said insect while said lash is retained at said rod distal end without disconnection therefrom (P. 1, ll. 66-74).

24. Kopp fails to disclose the lash including a pair of identical annular rubber bands joined together at a knot therebetween.

25. Kopp additionally discloses gripping said handgrip to aim said rod distal end at said insect and the lash spontaneously contracting for swatting said insect (Fig. 1).

26. Kopp does not describe specific dimensions of the lash but suggests modification of size, shape, form and material. P. 1, ll. 76-79.

27. Stone teaches a latch stop 14 adjacent a latch (“hammer”) for limiting rotation thereof (by collision of surfaces 30 and 14) when the stretched lash 33 (“elastic band”) pulls the latch into spontaneous abutment with the stop 14 as the lash 33 distal end is released from the latch to spontaneously contract the stretched lash (Col. 2, ll. 47-50).

28. A purpose of the latch stop in Stone is to cause a “loud report similar to the crack of a rifle.” Col. 3, ll. 5-6 and 33-36.

## PRINCIPLES OF LAW

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of

nonobviousness. The key to supporting any prima facie conclusion of obviousness under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, \_\_\_, 127 S. Ct. 1727, 1731 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness grounds cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). *See also KSR*, 550 U.S. at \_\_\_, 127 S. Ct. at 1741.

The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. *KSR*, 127 S. Ct., at 1739. A prima facie conclusion of obviousness may be supported by a showing that the claims are directed to a process, machine, manufacture, or composition of matter already known in the prior art that is altered by the mere substitution of one element for another known in the field, and such modification yields a predictable result. *See Id.* (citing *United States v. Adams*, 383 U.S. 39, 40). The Supreme Court further stated that:

[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

*KSR*, 127 S. Ct., at 1740. When considering obviousness of a combination of known elements, the operative question is thus “whether the improvement is

more than the predictable use of prior art elements according to their established functions.” *Id.*

Minor differences between the prior art and a claimed device may be a matter of design choice absent evidence to the contrary. *See In re Rice*, 341 F.2d 309, 314 (CCPA 1965).

Regarding a claim preamble, *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999) provides:

If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is “necessary to give life, meaning, and vitality” to the claim, then the claim preamble should be construed as if in the balance of the claim.

If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Id.*

## ANALYSIS

Initially, we note, Appellant’s Brief presents arguments relating to 37 C.F.R. § 1.104 (Br. p. 13). It is not the province of the Board to superintend the examination process. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP §1002 and § 1201.

*The rejection of claims 1, 3, 5, 10-12, and 14-22 as being obvious over White and Watkins and the rejection of claim 9 under as being obvious over White and Watkins and further in view of Robinson is affirmed.*

Appellant individually argues each of the above claims. Appellant argues that White, Watkins and Robinson fail to disclose or render obvious features of claims 1, 3, 5, 6, and 8-23. These arguments have been carefully considered. These arguments are not persuasive with respect to claims 1, 3, 5, 9-12, and 14-22 for the following reasons.

White discloses all features of claims 1, 3, 5, 10-12, and 17-21 except for a lash that is fixedly joined and retained to said rod distal end in a keyhole slot and the capability of whipping or swatting said lash distal end in extended striking range against said insect while said lash is retained at said rod distal end without disconnection therefrom (Facts 1-3, 5, 6, 10, 13, 16-18). Watkins teaches that it is known in the art of rubber band guns to fixedly join a lash 14 proximal end to a rod 10 distal end (at 34) so that the lash distal end (at 16) can be whipped (about 34) with said lash 14 being retained at the rod distal end at a keyhole slot 34 without disconnection therefrom (Facts 4 and 11). Watkins additionally teaches that it is known in the art that rubber band guns may be converted between a first operational mode wherein, upon firing, the rubber band is ultimately retained on the gun and a second operational mode wherein, upon firing, the rubber band is entirely discharged from it (Fact 12). Combining the familiar elements of White and Watkins according to the known method of interchanging a fixed end and free end of the band as described in Watkins does no more than yield the predictable result of converting a rubber band shooting gun into a

rubber band whipping gun. This result is expressly suggested in Watkins and therefore would have been obvious to one having ordinary skill in the art.

Appellant argues that the bands of White are not identical as required by claims 1 and 20. Br. pp. 25, 53. The bands of White, being cut from tire tubes, will be identical in all aspects except potentially height (Fact 3). From Figure 1, it can be observed that White intended the bands to be identical in that respect as well. It is more probable than not that the bands of White are “identical” within the broadest reasonable interpretation of that term.

Furthermore, White also suggests using bands of suitable length and strength (Fact 19) but leaves it up to the practitioner to determine the characteristics making the bands suitable. Appellants acknowledge that the invention may be practiced using “standard rubber bands commercially available at common stationery supply stores” (Fact 21). Rubber bands are generally available in packages containing multiple identical bands. The use of standard, commonly available rubber bands which are identical is a matter of design choice which does no more than yield the predictable result of facilitating construction of the device. Therefore, even if the use of identical bands was not expressly disclosed in White it would have been obvious to one having ordinary skill in the art.

For these reasons, claims 1, 3, 5, 10-12, and 17-21 are rendered obvious by the combination of White and Watkins.

White discloses all features of claims 14-16, and 22 except for those pertaining to the specific dimensions of the rod and rubber bands (Fact 19). It is also noted that the length of the rubber band in claim 14 is described in terms of the distance, “cocked length,” between the keyhole slot and latch. This distance is only present upon the modification of White with the

teachings of Watkins to include a keyhole slot. It amounts to the distance from the latch to the opposite end of the stretched rubber band. Again, White suggests using bands of suitable length and strength (Fact 19) but leaves it up to the practitioner to determine the characteristics making the bands suitable. Watkins acknowledges that variation of the dimensional characteristics of the rubber band will affect the force transferred to the projectile (Fact 20). One of ordinary skill in the art would recognize that the force transferred to the projectile is affected by the dimensional changes of the band because those changes affect the force the band itself is capable of transmitting. Selecting specific dimensional characteristics of the band is a matter of design choice which does no more than yield the predictable result of altering the force output of the band and therefore would have been obvious to one having ordinary skill in the art.

White and Watkins disclose all features of claim 9 except for the keyhole slot opening downwardly (Fact 14). Robinson teaches that it is known in the art of rubber band guns that a means for securing an end of a lash may open downwardly in a direction opposite to an upward extension of a latch in order to loosely (i.e., detachably) join the lash to the rod (Fact 15). Simply substituting a known upwardly facing opening with a known downwardly facing opening does nothing more than yield the predictable result of detachably securing the band to the distal end of the gun and therefore would have been obvious to one having ordinary skill in the art. It is noted that Robinson is cited not for the keyhole slot itself as suggested by Appellant (Br. p. 60) but for teaching that it is known to orient the opening of a band retaining means downwardly. Furthermore, the direction of the



opening is a matter of design choice which yields the predictable result of retaining the band.

Appellant additionally argues that White, Watkins, and Robinson are non-analogous art because they are not directed to insect swatters (Br. pp. 14-15, 58-63; Re. Br. pp. 2-3). This argument is not persuasive with regard to the apparatus claims because the limitations directed to swatting insects are recited only as intended use. The body of the claim fully sets forth a complete device describing the claimed invention. Limitations in the preamble are not necessary to breathe life and meaning into the claim.

Furthermore, “[A] prior art reference is analogous if it is from the same ‘field of endeavor’ even if it addresses a different problem.” The field of endeavor is not necessarily limited by the intended use of the device. A skilled artisan would have viewed White, Watkins and Robinson as being in the same field of endeavor or at least reasonably pertinent to the problem of killing insects by swatting them with rubber bands.

Appellant additionally argues that modification of White with the keyhole slot of Watkins would render White inoperable for its intended purpose of discharging rubber bands because it would be unable to do so if modified with the keyhole slot of Watkins. Firstly, the intended purpose of White is to provide a toy. To this end White describes discharging the entire band from the gun. There is no evidence to support the proposition that White would cease to be operable as a toy if an end of the band were fixed to the distal end of the gun. Secondly, the portion of White discussing the intended purpose describes aiming, catapulting through the air, and discharging the rubber band. None of these objectives necessarily requires that the entire rubber band be completely discharged from the gun to achieve

the overall objective of White. Appellant additionally argues that modification of Watkins with the teachings of White by removing pouch 16 would render Watkins inoperable for its intended purpose. Re. Br. p. 14. This assertion is in error since such a modification is explicitly suggested in Watkins (Fact 12).

*The rejection of claims 6, 8 and 13 under 35 U.S.C. § 103(a) as being obvious over White and Watkins is reversed.*

Appellant argues that White and Watkins do not render claims 6, 8 and 13 obvious because the steps of gripping said handgrip to aim said rod distal end at said insect; and the lash spontaneously contracting for swatting or whipping said insect; are not intended use limitations but are, instead, positive recitations of the steps of the claimed method; and, those steps are not disclosed or rendered obvious by White and Watkins. This argument is persuasive. The steps of gripping said handgrip to aim said rod distal end at said insect; and the lash spontaneously contracting for swatting or whipping said insect are limitations of the method claim, not merely statements of intended use. The combination of White and Watkins fails to disclose or suggest these recited steps (Fact 9) and therefore fails to render claims 6, 8 and 13 obvious.

*The rejection of claim 23 under 35 U.S.C. § 103(a) as being obvious over White and Watkins is reversed.*

Appellant argues that White and Watkins do not render claim 23 obvious because White and Watkins fail to disclose or suggest a latch stop which has the latch pulled into spontaneous abutment therewith “as said lash distal end is released from said latch.” This argument is persuasive. The

latch stop in White 14 is not pulled into abutment with the latch as the lash is released. It is instead released from the latch as the lash is released. White does not disclose any structure corresponding to the claimed latch stop and Watkins does not cure this deficiency. Accordingly, the combination of White and Watkins fails to render claim 23 obvious.

*Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter new grounds of rejection of claims 1, 3, 5, 6, and 22 under 35 U.S.C. § 103(a) as being obvious over Kopp (US 1,009,531) in view of White.*

Kopp discloses all features of claim 1 except the lash including only a pair of identical annular rubber bands joined together at a knot therebetween (Fact 23 and 24). White teaches it is known in the art to provide a lash including only a pair of identical annular rubber bands joined together at a knot therebetween (Facts 1 and 3). Simple substitution of the White lash for that of Kopp does no more than yield the predictable result of sizing the lash appropriately for the gun, for example, where a different sized gun is produced, and therefore would have been obvious to one having ordinary skill in the art.

White additionally teaches the latch and trigger elements of claims 3 and 5 (Facts 5 and 6). Simple substitution of the latch and trigger mechanism of White for that of Kopp does no more than yield the predictable result of providing an alternate structure enabling selective release of the band upon pulling the trigger and therefore would have been obvious to one having ordinary skill in the art.

Kopp, as modified with the lash, latching and triggering mechanism taught by White teaches all the steps recited in claim 6 (Facts 9 and 25).

The specific dimensional characteristics of the lash recited in claim 22 are not discussed in Kopp, or White (Facts 19 and 26). Kopp acknowledges that dimensional modifications may be made (Fact 26). White suggests using bands of suitable length and strength (Fact 19) but leaves it up to the practitioner to determine the characteristics making the bands suitable. One of ordinary skill in the art would recognize that dimensional changes affect the force the band is capable of transmitting. Selecting specific dimensional characteristics of the band is a matter of design choice which does no more than yield the predictable result of altering the force output by the band and therefore would have been obvious to one having ordinary skill in the art

*Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter new grounds of rejection of claims 8, and 10-21 under 35 U.S.C. § 103(a) as being obvious over Kopp in view of White and Watkins.*

Kopp discloses all features of claim 10-12, 17-21, except for elements of the lash, latch, trigger and keyhole slot (Fact 10 and 23). White teaches the claimed lash, latch, and trigger (Facts 1, 3, 5, 6, 13, 16-18). Watkins teaches use of a keyhole slot (Facts 4 and 11). Simple substitution of the White lash for that of Kopp does no more than yield the predictable result of sizing the lash appropriately for the gun and therefore would have been obvious to one having ordinary skill in the art. Simple substitution of the latch and trigger mechanism of White for that of Kopp does no more than yield the predictable result of enabling selective release of the band and therefore would have been obvious to one having ordinary skill in the art. Simple substitution of the keyhole slot of Watkins for the pin or staple of Kopp does no more than yield the predictable result of retaining the rubber band at the

distal end of the rod and therefore would have been obvious to one having ordinary skill in the art.

Kopp, as modified with the lash, latching and triggering mechanism taught by White teaches all the steps recited in claims 8 and 13 (Facts 9 and 25).

The specific dimensional characteristics of the lash recited in claims 14-16 are not discussed in Kopp, White or Watkins (Facts 19 and 26). Kopp acknowledges that dimensional modifications may be made (Fact 26). White suggests using identical bands of suitable length and strength (Facts 3 and 19) but leaves it up to the practitioner to determine the characteristics making the bands suitable. Watkins acknowledges that variation of the dimensional characteristics of the rubber band will affect the force transferred to the projectile (Fact 20). One of ordinary skill in the art would recognize that the force transferred to the projectile is affected because dimensional changes affect the force the band is capable of transferring. Selecting specific dimensional characteristics of the band is a matter of design choice which does no more than yield the predictable result of altering the force output by the band and therefore would have been obvious to one having ordinary skill in the art.

*Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claim 9 under 35 U.S.C. § 103(a) as being obvious over Kopp in view of White, Watkins and Robinson.*

Kopp, White and Watkins disclose all features of claim 9 except for a keyhole slot that opens downwardly (Fact 14). Robinson teaches that it is known in the art of rubber band guns that a means for securing an end of a

lash may open downwardly in a direction opposite to an upward extension of a latch to loosely join the lash to the rod (Fact 15). Substituting a known upwardly facing opening with a known downwardly facing opening does nothing more than yield the predictable result of detachably securing the band to the distal end of the gun and therefore would have been obvious to one having ordinary skill in the art. Furthermore, the direction of the opening is a matter of design choice which yields predictable results. *See In re Conte* 36 Fed. Appx. 446, 451, 2002 WL 1216965.

*Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claim 23 under 35 U.S.C. § 103(a) as being obvious over Kopp in view of White and further in view of Stone (US 2,505,591).*

Kopp and White fail to disclose the latch stop of claim 23. Stone teaches the claimed latch stop (Fact 27). Modifying Kopp and White to additionally include the latch stop of Stone amounts to using known elements according to their established functions in order to achieve the predictable result of stopping the latch and creating a noise (See Fact 28). This modification would have been obvious to one having ordinary skill in the art.

#### CONCLUSION OF LAW

On the record before us, Appellant has not established that the Examiner erred in rejecting claims 1, 3, 5, 10-12, and 14-22 as being obvious over the combination of White and Watkins. Appellant has not established that the Examiner erred in rejecting claim 9 as being obvious over the combination of White, Watkins, and Robinson. Appellant has

established that the Examiner erred in rejecting claims 6, 8, 13 and 23 as being obvious over the combination of White and Watkins.

### DECISION

For the above reasons, the Examiner's rejection of claims 1, 3, 5, 9-12, and 14-22 is affirmed and the Examiner's rejection of claims 6, 8, 13 and 23 is reversed. Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter new grounds of rejection of claims 1, 3, 5, 6, and 8-23.

### FINALITY OF DECISION

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejections of one or more claims, this decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (2008). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

vsh

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